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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92053617
Party	Defendant Battat Incorporated
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Date	06/09/2011
Attachments	92053617.PDF (5 pages)(51786 bytes)

In re Registration No. 3166567
Mark: B CUTE

BLUE BOX TOY FACTORY, LTD.

Petitioner,

VS.

BATTAT INCORPORATED,

Respondent.

Cancellation No.: 92053617

RESPONDENT'S OPPOSITION TO PETITIONER'S MOTION TO SUSPEND PROCEEDINGS

Battat Incorporated (hereinafter “Registrant” or “Respondent”) hereby opposes the motion by Blue Box Toy Factory, Ltd. (hereinafter “Petitioner”) to suspend the instant proceeding before the Trademark Trial and Appeals Board (hereinafter the “Board”) until the final determination of the federal civil action *Battat, Inc. v. Blue Box Toy Factory Limited*, Case No. 1:10-cv-09573-PGG (SDNY) (hereinafter the “Civil Action”) now pending before the Hon. Paul G. Gardephe in the United States District Court for the Southern District of New York. Contrary to Petitioner’s assertions, the Civil Action will not have a direct and conclusive bearing on this proceeding and thus suspension here is believed inappropriate.

RELEVANT FACTUAL BACKGROUND

Respondent filed the Civil Action asserting, among other things, claims under the Lanham Act for Petitioner's infringement of Respondent's B. Mark, which is used in connection with the sale of its B. line of young children's developmental toys. Petitioner was using its B_{kids}

mark in connection with similar goods.

In its filings seeking a Preliminary Injunction in the Civil Action, Respondent, as evidence of priority over Petitioner's B_{kids} mark, relied on a family of B Marks, which included, among others, the B CUTE Mark, the subject of the present cancellation proceeding. As one of its sixteen affirmative defenses, Petitioner challenged the validity of Respondent's rights to the B CUTE Mark in its Answer in the Civil Action but did not otherwise seek a declaration of the rights to, or cancellation of, the B CUTE Mark.¹ Petitioner has not sought nor demanded any Court determination of a cancellation of the B CUTE Mark in its Prayer for Relief in either of its Counterclaims in the Civil Action. Conversely, Respondent's B. Mark is not the subject of the present cancellation proceeding, nor is Petitioner's B_{kids} mark. Because the marks at issue in the Civil Action are different from the sole mark at issue in the instant proceeding, and because a final determination in the Civil Action will not affect the registration or validity of Respondent's B CUTE Mark, Petitioner's motion to suspend should be denied.

ARGUMENT

The instant action should not be suspended. Though the Board has discretion under 37 C.F.R. § 2.117(a) and TBMP § 510.02(a) to suspend a proceeding before it when a party to a pending case is also involved in a civil action bearing on the same matter, to do so here would be improper. In determining whether suspension is appropriate, the Board considers whether final determination in a related civil action will be conclusive as to the issues involved in the cancellation proceeding. *See The Seven-Up Co. v. Bubble Up Co.*, 136 U.S.P.Q. 210, 211 (C.C.P.A. 1963) ("The final determination [of the civil action] probably will be conclusive as between the parties with respect to the questions of respondent's right to the continued use of the

¹ A copy of Petitioner's Answer and Counterclaims in the Civil Action is attached to Petitioner's Motion to Suspend as Exhibit B.

mark shown in its registrations and of petitioner's claim of probable damage herein").

Here, Petitioner asserts that the issue of Respondent's "trademark rights to the mark B CUTE are specifically disputed in the Civil Action and will therefore be subject to final adjudication by the district court." Motion to Suspend, p. 2. This assertion is flatly incorrect. The Civil Action, as indicated by the Complaint, was brought by Respondent to enforce its rights to its B. Mark for use in connection with young children's developmental toys. Indeed, there is no reference to the B CUTE Mark whatsoever in either of Respondent's Claims for Relief as contained in the Complaint, or, more tellingly, in Petitioner's Counterclaims. As such, Petitioner specifically chose not to litigate the issue of Respondent's rights to the B CUTE Mark to final adjudication in the Civil Action and should therefore be precluded from relying on it as a reason for suspension here.

Further, several of the cases Petitioner relies upon in its motion are inapposite because in each one, the movant had also sought a cancellation in the Civil Action. *See Whopper-Burger, Inc. v. Burger King Corp.*, 171 U.S.P.Q. 805, 807 (T.T.A.B. 1971) (noting that petitioner had "asked the United States District Court to direct the Patent Office to cancel Registration No. 782,990 here involved"); *In re Alfred Dunhill Ltd.*, 224 U.S.P.Q. 501, 504 (T.T.A.B. 1984) ("In the civil action, applicant...sought to cancel the cited registration"). Petitioner here has sought neither a Court declaration of the B CUTE Mark's invalidity, nor the cancellation of the B CUTE Mark, nor any relief at all with respect to a determination of the ultimate rights to the B CUTE Mark.² Because such a determination has not been sought and will not issue in the Civil Action, Petitioner's motion to suspend should be denied.

² It smacks of gamesmanship for Petitioner, the Defendant in the Civil Action for trademark infringement of one mark, to commence a cancellation proceeding before the Board regarding another mark, then point to that proceeding's pendency as a basis in the Civil Action for denial of preliminary injunctive relief while not demanding there any relief for cancellation of the mark, and then demand a stay of the very proceeding it initiated, stating that the Civil Action already has the issue before it.


CONCLUSION

WHEREFORE, Respondent respectfully requests that the Board deny Petitioner's motion to suspend this proceeding.

Dated: New York, New York

June 9, 2011

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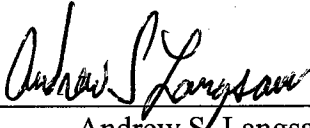
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CERTIFICATE OF SERVICE

I hereby certify that on June 9, 2011, I served Respondent's Opposition to Petitioner's Motion to Suspend Proceedings upon Petitioner's counsel by electronic and first class mail at the address in the Record:

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Dated: New York, New York
June 9, 2011



Andrew S. Langsam